

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE F. McINTYRE and LORETTA E. ALLEN

Appeal No. 2006-1643
Application No. 09/845,589
Technology Center 3722

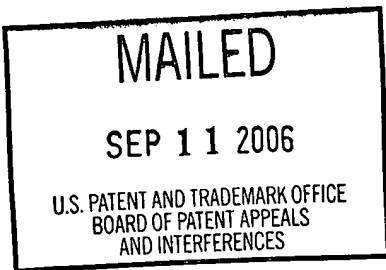
ON BRIEF

Before OWENS, LEVY, and FETTING, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4, 6, 8, 10-15, 17, 18 and 20-27, which are all of the claims pending in this application.

We AFFIRM-IN-PART.



BACKGROUND

The appellants' invention relates to forming a scrapbook page with images of different characteristics (specification, page 1).

Claim 1 is representative of the invention, and is reproduced as follows:

1. A method of arranging a series of at least two visual images of different characteristics of the same image and fixing them to a page which is usable in a scrapbook, comprising:

using a photographic digital image to produce a series of digital images of the same image where each of the digital images of the same image have different characteristics specified by a user;

forming visual images of the series of different characteristics of images on a single photographic print medium distinct from the page;

forming a visual image of printed instructions for making the scrapbook on the single photographic print medium;

allowing the user to manually cut out the series of different characteristics of visual images from the medium in accordance with the instructions; and

allowing the user to manually fix the cut out different visual images on the page forming a composite image on the page in accordance with the instructions which can be used in the scrapbook.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Monn	5,712,005	Jan. 27, 1998
Morag	6,324,545	Nov. 27, 2001

<http://film.icpenneyportraits.com> (FJCP), (February 7, 2001)

Claims 1, 3, 4, 6, 8, 10-15, 17, 18 and 23-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over FJCP in view of Monn.

Claims 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over FJCP in view of Monn and Morag.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed April 21, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed March 21, 2005) for the appellants' arguments thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claims 1, 3, 4, 6, 8, 10-15, 17, 18 and 23-27 under 35 U.S.C. § 103(a) as being unpatentable in view of FJCP in view of Monn.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed

invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We begin with claim 1. The examiner's position (answer, page 4) is that FJCP does not explicitly disclose manually fixing the cut-out visual images on a page to form a composite image which can be used in a scrapbook, but that it was well known in

the art to cut out digital images for scrapbooking purposes. The examiner turns to Monn for a teaching of cutting out images and fixing them to a surface in a scrapbook.

Appellants' position (brief, page 8) is that there is no teaching or suggestion in FJCP concerning making scrapbook pages. Appellants note that claim 1 calls for the instructions and visual images to be formed on the photographic print medium, and that in contrast, there is no suggestion in FJCP to place the greeting on photo stock. It is argued (id.) that a greeting on a greeting card is not instructions for making a scrapbook page.

With respect to Monn, appellants assert that Monn shows a separate sheet having instructions and says nothing about combining the instructions with the photo on the same medium, much less a photographic medium.

Appellants further assert (id.) that claim 1 requires

allowing the user to manually cut out the series of different characteristics of visual images from the medium in accordance with the instructions; and allowing the user to manually fix the cut out different visual images on the page forming a composite image on the page in accordance with the instructions which can be used in the scrapbook.

It is argued to the effect that FJCP does not suggest scrapbook pages or forming a composite image, and that Monn says and suggests nothing about forming a scrapbook page or instructions

for cutting out images. Appellants add that tearing of an offending border is not teaching or suggesting anything about cutting out the series of images.

From our review of FJCP, we find that the reference discloses a Total Choice Collection that includes enhancements. A configuration can include a single sheet having printed thereon one 5x7, 3 wallets and 3 billfolds. From this disclosure, we find that the reference teaches providing a single sheet with three different sizes, or different characteristics, of a photo. In addition, FJCP discloses a greeting card that includes a portrait as well as a greeting thereon. The reference is silent as to the substrate the photo and the greeting are on. However, from the disclosure of a photo and a greeting on the greeting card, we find that both the photo and the greeting are on the photographic print medium, since whatever medium is used to print the photo and the greeting is the photographic print medium.

Turning to the greeting, we find that the content of the greeting is printed matter, and that the content of the greeting does not patentably distinguish from the prior art. Whether the printed matter is a statement such as "Announcing the Graduate" or instructions for creating scrapbook page from the photos does not have patentable weight. In addition, from the disclosure of

FJCP that the calendar can include a single enhancement or a multi-image enhancement, we find that an artisan would have been motivated to use a multi-image photo on the greeting card as well.

Claim 1 additionally recites that the user is allowed to cut out and fix the characteristics of an image onto a page for use as a scrapbook page. The claim does not recite that the cutting and fixing steps are actually carried out, but rather that a user is allowed to do so. In FJCP, a user is capable of cutting pictures out of the composite sheet with three different size photos (characteristics) of the same image and putting them together in a collage as a scrapbook page. Thus, we find that FJCP meets the limitations of claim 1. In any event, turning to Monn, we find that the reference describes a memory box for storing photos (col. 1, lines 15-17). In particular, a kit is described for decorating the photo storage box (col. 1, lines 56-58). The method for decorating the photo box includes making a photocopy of the photograph, tearing the edges from the photograph so that the border is torn completely around the periphery of the subject (col. 4, lines 18-22). An adhesive is then applied to the back of the photocopy and the torn photocopy is then pasted onto the surface of the box

(col. 4, lines 25-29). After about 30 seconds, another photograph is pasted onto the box (col. 4, lines 39-41). Preferably, a collage is assembled with the torn photocopies overlapping (col. 4, lines 46-48). Monn further discloses (col. 5, lines 21 and 22) that instead of a photo album, the book 12 may be a scrap book, and suggests that the book's contents might resemble the box's collage, which is meant to indicate the contents of the book (col. 2, lines 41-43).

From the disclosure of Monn of tearing off the border of a photo and pasting it to a surface, and forming a collage of overlapping photos, we find that an artisan would have been motivated to have the user cut out photos from the composite sheet of FJCP and past them onto a surface. From the disclosure of replacing the photo album with a scrap book, we find that an artisan would have been motivated to use the collage created from the composite pictures of FJCP as a page of a scrap book. In addition, from the disclosure of including the instruction sheet with the kit of Monn, we find that an artisan would have been motivated to replace the printed matter (greeting) of FJCP with another printed matter, i.e. the printed matter (instruction sheet) of Monn.

We are not persuaded by appellants assertion (brief, page 8) that there is no teaching or suggestion of making scrapbook pages in FJCP. From the nature of the problem to be solved, e.g., making a scrapbook page, we find that the user would be aware that an entire photographic sheet, such as the second sheet from the right on page 1 of FJCP could be put into a scrapbook as a scrapbook page. In addition, we find that a user would be motivated to put together a collage of pictures as a scrapbook page, as users will inherently know to create scrapbooks from pages made of photographs, etc.

We agree with appellants (brief, page 8) that Monn does not disclose putting the instructions on the same medium as the image. However, the instructions are printed matter that do not create a new and unobvious relationship between the printed matter (instructions) and the substrate (photographic medium). Because there is no functional relationship between the instructions and the substrate, we find that placing printed matter on the substrate with the photo does not result in the printed matter being given patentable weight based upon the facts in this case; see In re Ngai, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-1864 (Fed. Cir. 2004).

Nor are we persuaded by appellants' assertion (id.) that Monn says and suggests nothing about forming a scrapbook page. From the disclosure of Monn that the photo album can be replaced with a scrap book, and Monn's disclosure of overlapping photos to form a collage, we find that an artisan would have been motivated to form a collage of photos for use as a scrapbook page.

From all of the above, we agree with the examiner, for the reasons set forth in the answer, as amplified by our comments, that the combined teachings of FJCP and Monn would have suggested the invention of claim 1, within the meaning of 35 U.S.C. § 103. The rejection of claim 1 under 35 U.S.C. § 103(a) is sustained.

We turn next to claim 3. Appellants assert (brief, page 9) that FJCP has different size images on a sheet but not mirrored images or combinations of sizes, colors and mirrored images. Appellants add that Monn says nothing about mirrored images or combinations of sizes, colors and mirrored images. The examiner's position (answer, page 9) is FJCP as modified by Monn discloses the characteristics including different sizes.

We agree. Claim 3 recites that "wherein the characteristics include different sizes, colors, mirrored images or combinations thereof." From the use of the term "or" we find that the teaching of one of the listed items is sufficient to meet the

claim language. From the disclosure of FJCP of having different size images of the same photograph on the same photographic sheet (second picture from the right on page 1) we find that the limitations of claim 3 are met by the prior art. Accordingly, we do not agree with appellants that the claim requires mirrored images or combinations of sizes, colors and mirrored images. The rejection of claim 3 under 35 U.S.C. § 103(a) is sustained.

We turn next to claim 4. Appellants assert (brief, page 9) that the reasons provided regarding claim 1 also apply to claim 4. It is asserted that FJCP and Monn do not teach or suggest that the cutting or fixing operations need not be manual. It is additionally asserted (id.) that claim 4 calls for starting with a digital image for the series of images with different characteristics that could be non-photographic, such as a graphic image. It is argued that neither FJCP nor Monn teach or suggest that the series images need not be photographic images.

The examiner's position (answer, page 4) is that claim 4 is rejected for the same reasons as claim 1.

At the outset, we make reference to our findings, supra, with respect to the teachings and suggestions of FJCP and Monn. From our review of claim 4, we find that the claim is similar to claim 1, but recites the cutting and fixing steps instead of

steps allowing them to occur. The claim does not recite that the digital images are photographic images. However, neither does the claim preclude the images from being photographic images. From the disclosure of photographic images in FJCP and Monn, we find that the teachings of FJCP and Monn would have suggested the limitations of claim 4, for the same reasons as we sustained the rejection of claim 1, and additionally note that because FJCP discloses Smiles By Wire®, that the photographs are inherently digital. We are not persuaded by appellants assertions that the cutting and fixing steps need not be manually done because the claim language is met by the disclosure in the prior art of tearing (which suggests cutting) and fixing of the photographs into a collage. The rejection of claim 4 is sustained.

We turn next to claim 6. Appellants assert (brief, page 9) that "[c]laim 6 calls for fixing the cut out series of images using an adhesive. FJCP says nothing about cutting out or adhering a series of images. Monn discusses applying adhesive to the front and back of a single photocopy. Nothing is suggested about the features of claim 6." The examiner's position (answer, page 4) is that FJCP as modified by Monn discloses the cut-out images being fixed by using an adhesive. We agree. Claim 6 recites that the cut-out images are fixed using an adhesive.

From the disclosure of Monn of using an adhesive to paste the torn photographs into a collage (col. 4, lines 25-29 and 46-48) we agree with the examiner for the reasons advanced in the answer that the combined teachings of FJCP and Monn would have suggested fixing the cut-out images using an adhesive. The rejection of claim 6 is sustained.

We turn next to claim 8. Appellants assert (brief, page 10) that the reasons they set forth for the reversal of the rejection of claim 4 are repeated. In addition, it is argued that FJCP and Monn say or suggest nothing about making a digital image of a subject, and that there is no discussion of annotating the page with other information and inserting the page into a scrapbook. The examiner's position (answer, page 5) that FJCP as modified by Monn discloses the method of making a scrapbook page as set forth in the rejection of claim 1, and that the references disclose providing a collection of pictures to create a collage (page annotated with other pictures). We agree. At the outset, we make reference to our findings, supra, with respect to the teachings of FJCP and Monn. In addition, we find that from the disclosure of Monn of creating a collage as a composite of pictures, we agree with the examiner that the teachings and suggestions of FJCP and Monn would have suggested annotating the

photograph with other photographs, as recited in claim 8. We are not persuaded by appellants' assertion that the pictures of the prior art are not necessarily digital. From the disclosure of FJCP's online service having enhancements and SmilesByWire®, we find that the photographs are digital or would have suggested digital photograph processing. The rejection of claim 8 under 35 U.S.C. § 103(a) is sustained.

We turn next to claim 10. Appellants assert (brief, page 10) that the reasons for the reversal of the rejection of claim 8 are incorporated by reference. Appellants additionally argue that

Claim 10 also calls for forming at least one image that itself is a series of images ("forming at least one visual image of the series of different characteristics of images on a single medium distinct from the page"), and cutting out and fixing that series image. As noted previously Monn has a single photocopy of a photo example and FJCP discloses a sheet of photos example. These examples are not an image that is a series of images. FJCP and Monn say nothing about this.

The examiner's position (answer, page 5) is that claim 10 is rejected for the same reasons as claim 1.

At the outset, we make reference to our findings, supra, with respect to the teachings of FJCP and Monn. From the language of the claim we find that claim 10 recites in part "using a

digital image of the single image to produce a series of digital images of the same single image where each of the digital images of the same single image have different characteristics." We find nothing in the language of the claim that would require the images to be from different photographs. For example, a sequence of MPEG images can have the same image even though the images are in a series of images. What is required by this portion of claim 10 is that the images in the series of digital images from the single image have different characteristics. From the disclosure of FJCP that a single photographic sheet have three different sizes (characteristics) of the same image, we find that the three different size images on the same photographic sheet meets the claimed series of images as recited in claim 10. The rejection of claim 10 is sustained.

We turn next to claim 11. Appellants assert (brief, page 11) that

Claim 11 calls for the digital image to itself have plural images of the single image with the different characteristics. As noted previously Monn has a single photocopy of an [sic, a] photo example and FJCP discloses a sheet of photos example. These examples are not a digital image that is itself a plurality of images.

The examiner's position (answer, page 5) is that claim 11 is rejected for the same reasons as claim 1. We will not sustain

the rejection of claim 11 because we find no teaching or suggestion in the record, and the examiner has not pointed us to any teaching that would have taught or suggested "wherein the at least one digital image includes a plurality of images of the single having different characteristics and which are arranged as a single visual image" as recited in claim 11. We likewise cannot sustain the rejection of claims 12 and 13 because of their dependency from claim 11.

We turn next to claim 14. Appellants assert (id.) that [c]laim 14 calls adding to the montage of images created via the instructions of claim 10 by "providing other visual images on the scrapbook page either before or after fixing the visual image to the scrapbook page. FJCP and Monn say nothing about further adding to the montage." The examiner refers us to column 4, lines 38-52 of Monn for a teaching of providing other visual images after fixing the visual image.

At the outset, we make reference to our findings, supra, with respect to the teachings and suggestions of FJCP and Monn. From the disclosure of Monn (col. 4, lines 38-42) that 30 seconds after affixing the photocopy that has been pasted to the box, another photocopy can be pasted on the box, to assemble a collage of overlapping photocopies, we agree with the examiner that the

combined teachings of FJCP and Monn would have suggested providing other images to the scrapbook page before or after affixing the visual image to the scrapbook page, as recited in claim 14. The rejection of claim 14 is sustained.

We turn next to claim 15. Appellants (brief, page 12) incorporate by reference the previously argued reasons for reversal of the rejection of claim 1. Appellants additionally assert (id.) that

Claim 15 also calls for the method to include "following instructions for producing a series of digital images of a single same image where each of the digital images of the single same image have different characteristics". As discussed above, FJCP provides no instructions regarding producing images or how to use them. Monn provides instructions for making a box which is not relevant to the present invention feature.

The examiner's position (answer, page 5) is that claim 15 is rejected for the same reasons as claim 1.

From our review of claim 15, we find that the claim 15, like claim 10 requires the production of a series of images, and like claim 10 does not require that the images, which have different characteristics, are of different images. The fact that instructions are followed to produce the series of images does not patentably distinguish the claim from the prior art.

Accordingly, we sustain the rejection of claim 15 for the same reasons as we sustained the rejections of claims 1 and 10.

We turn next to claim 17. Appellants assert (brief, page 12) that claim 17 includes instructions about a visual arrangement of images and text, and that neither FJCP nor Monn address this. The examiner's position (answer, pages 5 and 6) is that

[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

We agree. Claim 17 recites that the instructions include a visual arrangement of images and text. The particular instructions recited are not functionally related to the substrate and do not distinguish claim 17 from the prior art.

The rejection of claim 17 under 35 U.S.C. § 103(a) is sustained.

We turn next to claim 18. Appellants' position (brief, page 12) is that the reasons for the reversal of the rejection of claim 1 are incorporated herein. Appellants add that there is no additional information printed along with the instructions taught or suggested by FJCP or Monn, as Monn has a separate instruction sheet and FJCP has no printed instructions. The examiner's position (answer, page 6) is that claim 18 is rejected for the same reasons as claim 1.

At the outset, we make reference to our findings, supra, with respect to the teachings and suggestions of FJCP and Monn. From our review of claim 18, the claim requires printing the visual information and instructions to facilitate a user cutting out the images and fixing them to the scrapbook page. From the disclosure of FJCP of the greeting card including the greeting (printed matter) and the photograph, we find that FJCP teaches or suggests printing out the photograph along with the printed matter on the same substrate. As to the printing of the instructions to facilitate the user in making the scrapbook page, we find that the instructions are non-functional descriptive material that do not produce a new and unobvious relationship between the descriptive material and the substrate. The

rejection of claim 18 is sustained for the same reasons as we sustained the rejections of claims 1 and 15.

We turn next to claim 23. Appellants rely upon the arguments presented for the reversal of the rejection of claim 1. Appellants additionally argue (brief, page 13) that FJCP and Monn say nothing about a user providing the images and say nothing about modifying a provided image. The examiner's position (answer, page 6) is that claim 23 is rejected for the same reasons as claim 1.

Claim 23 requires that at least one portion of a digital image is provided by the user and that the image is modified to provide a modified digital image of the same image. In FJCP, a user selects an image or images for purchase. By selecting an image from a number of images, we find that the user is providing the image to be digitally processed and printed. By making a Total Choice enhancement of the image, such as three different sizes of the image on a single substrate, we find a modified (by size) digital image of the same image. In addition, for the reasons advanced, supra, with respect to, inter alia, claims 1 and 15, we find that the printed matter is non-functional descriptive material that does not provide a new and unobvious relationship between the printed matter and the substrate. From

all of the above, we are not convinced of any error on the part of the examiner in rejecting claim 23. The rejection of claim 23 under 35 U.S.C. § 103(a) is sustained.

We turn next to claim 24. Appellants rely upon the arguments presented for the reversal of the rejection of claim 1. In addition, appellants assert (brief, page 13) that no scrapbook page method with the features of claim 23 is provided as a product or even suggested by FJCP or Monn. The examiner's position (answer, page 6) is that claim 24 is rejected for the same reasons as claim 1.

At the outset, we make reference to our findings, supra, with respect to the teachings and suggestions of FJCP and Monn. Claim 24 recites an image product produced by the method of claim 23. We will sustain the rejection of claim 24 for the same reasons as we sustained the rejection of claim 23, and add that the scrapbook page resulting from the combined teachings of FJCP and Monn would have suggested the limitations of claim 24, in the same manner as they meet the limitations of claim 23.

We turn next to claim 25. Appellants rely upon the arguments presented for the reversal of the rejection of claim 1. In addition, appellants assert (brief, page 14) that style

selection capability and production of images responsive thereto is not provided, taught or suggested by FJCP or Monn.

The examiner's position (answer, page 6) is that claim 25 is rejected for the same reasons as claim 1. Claim 25 recites, inter alia, "allowing the user to specify reproduction of the image as a series of images with different characteristics associated with a scrapbook page style" and "creating the images responsive to the style." This is met by the user in FJCP specifying the pictures to be printed as the Total Choice Collection where three different sizes of the same image are printed on the same photograph substrate. Upon selecting the style of three sizes of pictures on the same substrate and printing them, pictures of different sizes displayed on the single substrate, these limitations are met because nothing in the claim requires that different styles are presented to the user for selection, and in any event, the listing of portrait sizes and sheet configurations on page 4 of FJCP allows the user to choose the selection of three different sizes of the same picture on the same substrate as a page style. In addition, using the printed pictures to form a collage as taught by Monn would meet the claim because the claim does not recite who forms the collage of scrapbook page. From all of the above, we sustain

the rejection of claim 25 for the same reasons as we sustained the rejection of claims 1, 15 and 23.

We turn next to claim 26. Appellants rely upon the arguments presented for the reversal of the rejection of claim 25. In addition, appellants assert (brief, page 14) that FJCP and Monn do not contemplate "automatically selecting a set of scrapbook page assembly instructions responsive to the style where the instructions correlate to the series of images.

At the outset, we make reference to our findings, supra, with respect to the teachings and suggestions of FJCP and Monn. In FJCP, the user can automatically select the greeting (printed matter) by clicking on the circular icon to the left of the desired greeting. As to the content of the specific instruction, we find that the content does not establish a new and unobvious relationship between the instruction and the substrate it is printed on. In addition, an artisan would be motivated to provide whatever instructions necessary for the user. From all of the above, the rejection of claim 26 under 35 U.S.C. § 103(a) is sustained.

We turn next to claim 27. Appellants rely upon the arguments presented for the reversal of the rejection of

claim 25. In addition, appellants assert (brief, pages 14 and 15) that the images of the created series each have a unique printable identifier associated with each image. There is no such unique identifier or set of instructions provided or suggested by FJCP or Monn. The examiner's position is that claim 27 is rejected for the same reasons as claim 1.

At the outset, we make reference to our findings, supra, with respect to the teachings and suggestions of FJCP and Monn. In addition, we find the indicia on each image, such as numbering the images, is printed matter, that fails to establish a functional relationship between the indicia and the substrate upon which the picture is printed. Accordingly, the indicia does not patentably distinguish the claim over the prior art. In any event, from the disclosure of Monn of providing printed instructions, we find that an artisan would have been motivated to provide indicia such as numbering on the pictures, if needed, to assist the user in following the instructions. The rejection of claim 27 under 35 U.S.C. § 103(a) is sustained.

We turn next to the rejection of claims 20-22 under 35 U.S.C. § 103(a) as being unpatentable over FJCP in view of Monn and Morag. We begin with claim 20. The examiner's position (answer, page 6) is that FJCP and Monn do not teach sending a

digital image over a communication channel to a service provider with instructions to the service provider. To overcome this deficiency of FJCP and Monn, the examiner turns to Morag for a teaching of

[A] method of generating a personalized photo album comprising using digital images transmitted over a service provider. The images and instructions are transmitted by digital means such as over the Internet. The service provider prints the images on a single sheet of paper. Once the album is complete, an electronic proof copy may be sent to the customer for approval having computer-readable instructions for viewing and/or printing of the album. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify FJCP's invention to include instructions, as taught by Morag, for providing information related to the album between the customer and the service provider.

Appellants rely upon the arguments presented for the reversal of the rejection of claim 1. In addition, appellants assert (brief, page 15) that

Claim 20 also calls for "the user sending a digital image over a communication channel to a service provider with instructions to the service provider, such service provider using the digital image produces a series of digital images of the same image where each of the digital images of the same image have different characteristics in accordance with the instructions and sends such digital images series to the user." FJCP and Monn do not address this. Morag does not teach or suggest anything about instructions to the service provider that instruct the production of "a series of digital images of the same image where each of the digital images of the same image have different characteristics."

From the disclosure of Morag (col. 1, lines 52-62) of the customer acquiring digital images; transmitting the images to the service provider; the service provider arranging the images into an album; printing the images and assembling the album; including arranging images on pages and grouping pictures together (col. 1, lines 49-51); storing the proof album at an Internet site (col. 3, lines 41-48); generating composite images comprising an image mosaic from a plurality of overlapping images (col. 4, lines 52-54), and having an instruction store which stores instructions for arrangements (col. 5, lines 16-19), we find that an artisan would have been motivated to use a service provider that is sent the picture by the user to create the scrapbook page suggested by the combined teachings of FJCP and Monn. That is, instead of going to the FJCP site and selecting a picture and sheet configuration, that a user would be taught to send a picture to the provider, with instructions for a collage picture sheet or sheets, and have the provider follow the user's instructions in creating the album requested by the user. Accordingly, we are not convinced of any error on the part of the examiner in rejecting claim 20 under 35 U.S.C. § 103(a). The rejection of claim 20 under 35 U.S.C. § 103(a) is sustained. In

addition, we will sustain the rejection of claim 21 because FJCP's disclosure of charges for different products would have suggested to an artisan making payment to the provider for the product received. We will likewise sustain the rejection of claim 22 in view of Morag's disclosure of accessing the provider over the Internet. Since the provider is being contacted by the user over the Internet, the provider would have been motivated to accept payment from the purchaser over the Internet, due to the common use of the Internet as a way to pay for products ordered over the Internet.

To summarize, the decision of the examiner to reject claims 1, 3, 4, 6, 8, 10, 14, 15, 17, 18 and 20-27 under 35 U.S.C. § 103 is affirmed. The decision of the examiner to reject claims 11-13 under 35 U.S.C. § 103(a) is reversed.

AFFIRMED-IN-PART

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

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